

REMARKS

This responds to the Office action mailed November 26, 2003 and supplements Amendment A.

Applicants traverse the restriction requirement for the reasons stated below.

Applicants elect the Group II claims for prosecution if the Office does not withdraw the restriction requirement.

Reconsideration is respectfully requested of the restriction requirement and, in particular, of the reason stated in the Office action for the restriction requirement. It is stated in the Office action that "the process [of claim 1] may be practiced by another materially different composition" other than the solder paste of claim 25. However, the method of claim 1 as amended is as follows:

Claim 1. A method of printing a solder paste onto a substrate surface, the method comprising: (a) placing a stencil over the substrate surface; (b) printing the **solder paste comprising a lubricant additive through the stencil, wherein the lubricant additive is a branched chain fatty alcohol or fatty acid comprising 8 to 50 carbon atoms with a minimum of 4 carbon atoms being present in the shorter alkyl chain, or ester thereof**; and (c) removing the stencil from the substrate surface.

The solder paste of claim 25 is as follows:

Claim 25. A solder paste comprising a solder powder and a non-aqueous vehicle, wherein the non-aqueous vehicle comprises a lubricant additive which is a branched chain fatty alcohol or fatty acid comprising 8 to 50 carbon atoms with a minimum of 4 carbon atoms being present in the shorter alkyl chain, or an ester thereof.

There is no way to practice the process of claim 1 without using a solder paste as set forth in claim 25. As such, it is respectfully submitted that amended claim 1 and claim 25 are not directed to "distinct inventions" as set forth in MPEP 803.

Additionally, applicants ask the Examiner to consider the relative burdens on himself and the applicant. In order for a reliable search to be conducted for either applicant's product or process claims, both Class/subclass combinations will have to be searched. Accordingly, maintaining all claims in the application should not add more than a minimal burden. Further, applicants have minimized any such additional burden by substantially reducing the number of claims and presenting them in a manner of parallel product and process claims. In this regard the Examiner is asked to consider MPEP 803 which states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even if it includes claims to distinct or independent inventions." (emphasis added).

Applicants respectfully submit that the burden of examining one additional independent claim and nine claims depending therefrom having overlapping search fields cannot fairly be said to be "serious." In contrast, applicant would incur filing fees of about \$800, issue fees of over \$1000, and maintenance fees of about \$5000 or more if required to prosecute and maintain a second application/patent, such fees being in addition to the similar fees to be incurred in this first application.

Applicants further emphasize that the Office often examines both product and process claims in the same application in situations such as this. Recent analogous patents issued to applicants' assignee include the following:

6,599,372

Claim 1. A soldering flux comprising. . . .

Claim 8. A method for treating a printed circuit board comprising the steps of. . . .

6,467,641

Claim 1. A container device for holding and immobilizing solder spheres comprising. . . .

Claim 22. A method for immobilizing solder spheres comprising steps of. . . .

6,345,718

Claim 1. A containing device to hold and immobilize solder spheres comprising. . . .

Claim 7. A method of immobilizing solder spheres in storage and during transport comprising steps of. . . .

6,331,201

Claim 1. A coating composition that is effective for immersion plating a coating of bismuth metal onto a copper-containing surface. . . .

Claim 2. A method of protecting a copper-containing surface, comprising. . . .

These are not isolated instances, as the patent collection is replete with such patents. While this is not controlling on the Examiner in the present case, applicants respectfully request that it be taken into account when weighing the relative burdens,

CEDA 7002
PATENT

the closely parallel nature of applicants' few method and few product claims, and the overlapping, if not identical, nature of the respective searches required.

In view of the foregoing, applicants respectfully ask the Examiner to withdraw the restriction requirement.

Applicants' Amendment A concluded with the following statement:

"As required by 37 CFR 1.143, applicants provisionally elect the Group II claims for prosecution (claims 25-31, 34, 37, and 38) in the event that the restriction requirement is made final."

Applicants traverse the restriction requirement for the reasons stated above, and elect the Group II claims for prosecution if the Office does not withdraw the restriction requirement.

Respectfully submitted,



Paul I. J. Fleischut, Reg. No. 35,513
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

PIF/leb

Express Mail No. EV 237015162 US